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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,315	02/16/2001	Taeyoung Yoon	49563-1 (72021)	7054

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EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/788,315

Applicant(s)
YOON et al.

Examiner
Emily Bernhardt

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-162 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-162 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26,30,42-130,133-146,154 and 162, drawn to compounds,compositions where Ar=phenyl or naphthyl, classified in class 544, subclass 336,408,409,and other subclasses in view of species such as morpholino and silyl;class 514 subclasses such as 252.1,255.06.
- II. Claims 3,9,18,19,24,25,131,132,154,and 162, drawn to compounds,compositions where Ar= hetero rings, classified in class 544, subclass 405 and others as may be determined by nature of rings present such as 295 when Ar=pyrimidinyl; class 514 subclasses such as 255.05,etc..
- III.. Claims 27-29,31-36,38-41,147-153,155-160, drawn to multiple uses employing compounds of I , classified in class 514, subclass es various as determined by the exact nature of species intended.
- IV. Claims 40-41,147-153,155-160, drawn to multiple uses employing compounds of II , classified in class 514, subclasses as may be determined by the exact nature of species intended.
- V. Claims 37 and 161, drawn to use for radiolabelled compounds of I or II as probes, classified in Class 436,subclass 504 and possibly other subclasses.

If any of groups I-IV are elected applicants must further elect a single species in view of the plurality of substituents permitted on the pyrazine ring.

If III or IV is elected applicants must select a single use for initial examination.

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The inventions are distinct, each from the other because:

Compounds of I and II are variously classified and are capable of supporting separate patents and would be expected to raise differing issues of patentability in view of the diversity of substituents permitted on Ar as well as remaining locations.

Inventions I-II and III-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case more than one use exists for the compounds as evidenced by the many being claimed herein. Additionally, the methods of use urged would raise additional issues of patentability- at the very least 112 issues regarding the sole reliance on CRF receptor binding affinity as a reasonable predictor of in vivo treatment for uses as varied as Alzheimer's, a neurological disorder to cardiovascular diseases as the specification alleges. Also compounds employed

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in use of V must be labelled and thus are independent from other uses employing nonlabelled derivatives.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier

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numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.



EMILY BERNHARDT

PRIMARY EXAMINER

GROUP 1600